

REMARKS

The Office Action has been received and carefully considered. The office action rejects claims 14, 15, 16 and 21 under 35 U.S.C. § 102(b) as allegedly being anticipated by Fred Dougliis and Thomas Ball, "Tracking and Viewing Changes on the Web," 1996 USENIX Technical Conference ("Dougliis"), rejects claims 17-20 and 25 under 35 U.S.C. § 103(a) as allegedly being obvious over Dougliis in view of U.S. Patent No. 5,727,159 to Kikinis *et al.* ("Kikinis"), and rejects claims 1, 2, 10-13, 22, 24 and 26-29 under 35 U.S.C. § 193(a) as allegedly being obvious over Dougliis in view of W. Richard Stevens, "UNIX Network Programming," Prentice Hall 1990 ("Stevens"). Applicants respectfully traverse these rejections and request reconsideration of claims 1-29 based on the following remarks.

I. The Claims Meet The Requirements of 35 U.S.C. § 101

Claims 22-29 have been rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. In particular, the Office Action posits that the claims must meet "a two prong test of: (1) whether the invention is within the technological arts; and (2) whether the invention produces a useful, concrete, and tangible result." Office Action, page 2. Applicants note that this alleged test refers to a "technological arts" requirement. Applicants respectfully traverse this rejection as follows.

Applicants respectfully direct the Examiner's attention to *Ex Parte Lundgren*, 2003-2088 (Bd. Pat. App. Int. 2004) (precedential opinion). In that decision, the Board of Appeals and Interferences ("Board") categorically declared that there is no "technological arts" requirement under § 101. As such, any rejection under § 101 that alleges a "technological arts" requirement

is improper and must be withdrawn. Furthermore, the Board reiterated that a case relied upon in the Office Action, *Ex Parte Bowman*, 61 USPQ2d 1665 (Bd. Pat. App. Int. 2001)(unpublished), is not a precedential opinion and therefore does not provide controlling authority. In view of *Lundren*, Applicants assert that the present claims are directed to statutory subject matter and request that the Examiner remove the rejection under § 101.

II. The Cited References Fail To Disclose That The Second Set Of Data May Be In Several Possible Formats

Claim 14 recites that “said second set of data ... being in any one of several possible formats.” None of the cited references, including Dougliis, disclose this limitation.

The Office Action’s reading of the “second set of data” is inconsistent with the “second set of data ... being in any one of several possible formats.” The Office Action interprets the “second set of data” as Dougliis’ “modification data of the page such as time of modification.” Office Action, page 5. Further, claim 14 states that the “second set of data” is “in any on of several possible formats.” Therefore, the Office Action’s reasoning requires that the “modification data” is in any of several possible formats. This is simply not the case. That is, the “modification data” that the Office Action alleges to be the “second set of data” is *not* “in any one of several possible formats.” Instead, Dougliis requires its modification data to be in a single, well-defined format so that it may be used to generate comparisons. Specifically, Dougliis teaches that its comparison algorithm generates a mapping from tokens of an old document to tokens of a new document *See* Dougliis, page 8, section 5.2. Dougliis’ technique cannot work if the comparison data is kept in multiple formats. That is, Dougliis requires a single format for its modification

data, otherwise Dougliš’ technique would not be able to present differences to the user. Accordingly, Dougliš fails to disclose “said second set of data ... being in any one of several possible formats.”

Anticipation under 35 U.S.C. § 102 requires that a prior art reference disclose each and every element of the claimed invention. *In re Sun*, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). MPEP § 2131, quoting *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), reinforces this principle: “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Because the cited references fail to disclose “said second set of data ... being in any one of several possible formats,” the rejections of claim 14 and all claims dependent thereon are improper and must be withdrawn.

III. Dougliš Fails To Disclose “Analyzing Said Second Set Of Data To Select A Second Subset Of Data Included In Said Second Set Of Data Based On A Prior Analysis”

Claim 14 recites “analyzing said second set of data to select a second subset of data included in said second set of data based on a prior analysis.” The cited references fails to disclose this limitation.

The Office Action does not address this limitation. That is, the Office Action fails to even allege that Dougliš discloses this limitation. In fact, Dougliš does not and cannot meet this limitation.

The Office Action takes the position that the “second set of data” corresponds to Dougkis’ “modification data of the page such as time of modification.” Office Action, page 5. That position is untenable. First, claim 14 requires selecting “a second subset of data included in said second set of data based on a prior analysis.” Dougkis fails to disclose selecting any subset of the “modification data.” Indeed, Dougkis fails to even consider any subset of the modification data. Second, Dougkis fails to disclose any “prior analysis,” let alone making a selection based on such “prior analysis.” Again, the Office Action does not address this limitation. In sum, Dougkis fails to disclose “analyzing said second set of data to select a second subset of data included in said second set of data based on a prior analysis,” and the Office Action does not allege otherwise.

Anticipation under 35 U.S.C. § 102 requires that a prior art reference disclose each and every element of the claimed invention. *In re Sun*, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). MPEP § 2131, quoting *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), reinforces this principle: “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Because the cited references fail to disclose “analyzing said second set of data to select a second subset of data included in said second set of data based on a prior analysis,” the rejections are improper and must be withdrawn.

IV. The Cited References Fail To Disclose The First Set Of Data Includes The Second Set Of Data

Claims 1 and 22 recite “said first set of data including a second set of data.” None of the cited references, including Dougliis, disclose this limitation.

Confusingly, the Office Action considers a limitation that *does not appear in claims 1 or 22*. Specifically, the Office Action considers, in relation to the rejection of claim 1, “a second set of data from a second predetermined data source.” *This limitation does not appear in claim 1*.

The Office Action takes the position that the “first set of data” corresponds to “the home pages that the web server sends to a client,” and that the “second set of data” corresponds to the “modification data of the page such as time of modification.” Office Action, page 7. This position is not tenable. The claim limitation at issue requires that the second set of data be included in the first set of data. Under the Office Action’s reasoning, this requires “modification data such as time of modification” to be included in “the home pages that the web server sends to the client.” This is simply false. Indeed, Dougliis is directed to identifying and tracking document modifications. If modification data were simply included in every document, as suggested by the Office Action, there would be no need for Dougliis’ technique. That is, modification data is *not* included in “the home pages that the web server sends to a client,” as would be required under the Office Action’s reasoning. As such, Dougliis fails to disclose “said first set of data including a second set of data.”

Under 35 U.S.C. § 103, all claim limitations must be taught or suggested in the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP § 2143 reinforces this principle: “[T]he prior art reference (or references when combined) must teach or suggest all the claim limitations.” Because the cited references fail to disclose “said first set of data including a second set of data,” the rejections of independent claims 1 and 22 and all claims dependent thereon are improper and must be withdrawn.

V. The Cited References Fail To Disclose Retrieving A Third Set Of Data From Said First Predetermined Data Source

Claims 1 and 22 recite “retriev[ing] a third set of data from said first predetermined data source.” None of the cited reference, including Dougliis, disclose this limitation.

The Office Action takes the position that the “third set of data” corresponds to “the differen[ce] between 2 documents as in Fig. 1, page 4.” Office Action, page 8. Elsewhere, the Office Action states that the “first predetermined data source” corresponds with Dougliis’ “particular web server that retrieves pages from WWW.” Office Action, page 7. However, the claim limitation requires that “the third set of data” be retrieved from “the first predetermined data source.” Thus, under the Office Action’s reasoning, the “the differen[ce] between 2 documents as in Fig. 1, page 4” must be retrieved from the “particular web server that retrieves pages from WWW.” This is false. Dougliis’ difference information is generated and stored separately from the pages from which it was derived. There is no indication that Dougliis’ technique stores difference information on the same server on which third-party web pages are stored. That is, Dougliis does not disclose retrieving “the differen[ce] between 2 documents as in Fig. 1, page 4” from the

“particular web server that retrieves pages from WWW,” and Dougliis cannot disclose the same because it is simply not true. In sum, Dougliis fails to disclose “retriev[ing] a third set of data from said first predetermined data source.”

Under 35 U.S.C. § 103, all claim limitations must be taught or suggested in the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP § 2143 reinforces this principle: “[T]he prior art reference (or references when combined) must teach or suggest all the claim limitations.” Because the cited references fail to disclose “retriev[ing] a third set of data from said first predetermined data source,” the rejections of claims 1 and 22 and all claims dependent thereon are improper and must be withdrawn.

VI. The Cited References Fail To Disclose Using Instructions To Select A Fourth Set Of Data Included In The Third Set Of Data

Claim 1 recites “building an agent, said agent comprising instructions based on said analysis of said semantics, syntax, or position of said second set of data, wherein said instructions are to be used by said agent to ... select a fourth set of data included in said third set of data.” Claim 22 recites “building an agent, said agent comprising instructions based on said step of analyzing semantics, syntax, or position of said second set of data, wherein said instructions are to be used to ... select a fourth set of data included in said third set of data.” The cited references, including Dougliis, fail to disclose this limitation.

The Office Action takes the position that the “third set of data” corresponds to “the differen[ce] between 2 documents as in Fig. 1, page 4.” Office Action, page 8. As best understood, the

Office Action states that the “fourth set of data” corresponds with certain difference information¹. The claim limitations at issue require the fourth set of data be included in the third set of data. Under the Office Action’s reasoning, this would require that certain difference information be included in “the differen[ce] between 2 documents as in Fig. 1, page 4.” Obviously, this is not the case. At most, these two items are identical, rather than being one included in the other. As such, the Office Action’s reasoning is flawed, and the rejection cannot stand.

Furthermore, the claim limitations at issue require that “instructions based on said analysis of said semantics, syntax, or position of said second set of data” be used to “select a fourth set of data included in said third set of data.” The Office Action fails to identify such instructions in any of the references. Applicants submit that this omission is due to the fact that the cited references do not disclose this limitation.

Under 35 U.S.C. § 103, all claim limitations must be taught or suggested in the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP § 2143 reinforces this principle: “[T]he prior art reference (or references when combined) must teach or suggest all the claim limitations.” Because the cited references fail to disclose using instructions to select a fourth set of data included in the third set of data, the rejections of the independent claims and all claims dependent thereon are improper and must be withdrawn.

¹ The Office Action is not clear. It states, “[w]hen the user decides to view the different or new version of the document, the system is displayed for user that information/data [sic] (see page 8, Presentation of the different). This information/data corresponds to the fourth set of data...” Office Action, page 8.

VII. The Motivation To Combine Is Deficient

The Office Action purports to reject claims 1, 2, 10-13, 22, 24 and 26-29 under 35 U.S.C. § 103(a) as being obvious over Dougliis in view of Stevens. However, the Office Action fails to establish a *prima facie* case of obviousness, at least because it fails to provide a proper motivation to combine.

The Office Action states, as its sole motivation to combine Dougliis with Stevens, that such a combination would “provide an automatic system so that the user does not have to input anything after the request.” First, this motivation is conclusory and unsupported. There is nothing in Dougliis or Stevens that would support this statement. Second, combining Dougliis with Stevens would *not* “provide an automatic system so that the user does not have to input anything after the request.” Stevens is a generic disclosure of “daemons.” There is no disclosure that using a daemon would relieve a user of having “to input anything after the request.” In short, the Office Action fails to present a *prima facie* case of obviousness.

Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Patent Office can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of references. *Id.* Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). That is, under 35 U.S.C. § 103,

teachings of references can be combined only if there is some suggestion or motivation to do so. *Id.* However, the motivation cannot come from the applicant's invention itself. *In re Oetiker*, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992). Rather, there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the art would make the combination. *Id.* Because the Office Action has not provided adequate motivation to combine, the rejections over Douglass in view of Stevens are fatally flawed and must be reversed.

VIII. Conclusion

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

No fee is believed to be necessary for entry and consideration of this Reply. In the event that the United States Patent & Trademark Office requires a fee to enter and consider the instant Reply or to maintain the application pending, please charge or credit such variance to the undersigned's Deposit Account No. 50-0206.

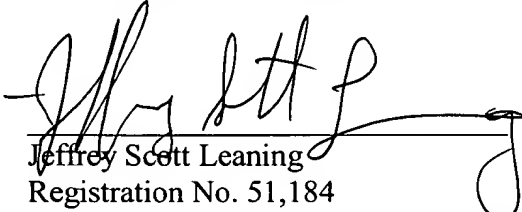
Respectfully submitted,

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Dated: February 13, 2006

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